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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,866	08/29/2001	Kazuyuki Hayashi	1417-360	5095
23117	7590	04/14/2005	EXAMINER	
NIXON & VANDERHYE, PC 1100 N GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201-4714			WYROZEBSKI LEE, KATARZYNA I	
		ART UNIT	PAPER NUMBER	
		1714		

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

1D

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/940,866	HAYASHI ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Katarzyna Wyrozebski	1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 February 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 56,57 and 61-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 56,57 and 61-116 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/7/2005</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

In view of applicant's amendment to the claims and declaration by Mr. Hayashi following office action is final necessitated by amendment. In the amendment the applicants have incorporated limitation of light resistance. Since as applicants have shown, light resistance is not an inherent property, new search was conducted and following rejections are restated.

***Double Patenting***

Properly filed Terminal Disclaimer was received only for the US Patent Number 6,596071.

Addition two rejections over the US Patent Number 6,623,557 and Application number 10/131,501 are not filed. These rejections are therefore not overcome.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 56, 57, 61-116 are rejected under 35 U.S.C. 103(a) as being unpatentable over SATOU (US 2003/0031615) in view of WINNIK (US 4,877,451).

The prior art of SATOU discloses composition for inks for jet printers, which has excellent light resistance and water resistance.

Silica of SATOU has BET of 500-1400 m<sup>2</sup>/g (Abstract), particle size of 0.02-20 microns and it can be utilized with a binder such as PVA, starch, latex and emulsions composition. [0050]. Additional pigments are selected from silica, alumina, zeolite and the like. Binders are utilized in amount of 5-300 pbw of silica.

The difference between the present invention and the disclosure of SATOU is recitation of gluing agent and dye.

The prior art of WINNIK discloses another composition for ink for ink jet printers comprising particle of silica, which is white particle that is coated with a dye molecule (organic) through silane coupling agent.

Silica of WINNIK has particle size of 10-20 nm (0.001 microns = 1 nm) and BET of 150-380 m<sup>2</sup>/g (col. 7, lines 33-37).

Coupling agents are silane coupling agents containing alkoxy groups, amino groups or both (col. 8, lines 5-17). Coupling agent is utilized in amount of 1-20 wt % by weight of silica.

Dyes compounds coated onto silane treated silica are organic dyes, examples of which are listed in col. 8, lines 23-64). Dye compound is utilized in amount of 1-30 pbw of silica.

The composition is coloring composition, which further comprises film forming resins such as acrylic resins. The composition comprises 65-98 wt % of silica in aqueous medium.

In the process of WINNIK a dispersion is formed of silica in liquid medium. Silane coupling agent is added and mixed with silica in order to provide surface treated silica (EXAMPLE IV, col. 18). Next pre-treated silica is dispersed again in water with dye compound (example VII, col. 20), wherein dye compound in particular example VII is blue.

The two disclosures, are in the same field of endeavor teaching ink compositions for ink jet printers. The combination of two known compositions is expected to work in additive or cumulative manner. *In re Kerkhoven* 626 E.2d 846, 850 205 USPQ 1069, 1072 (CCPA 1980). In addition using gluing agents affords better adhesion between silica and the dye.

IN the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize silica of SATOU with gluing agent and dye of WINNIK and thereby obtain the claimed invention. Such combination would still afford ink composition for ink jet printers.

In the amendment the applicants have filed declaration, which was very persuasive and showed clearly that the light resistance of the silica pigment depends on a process by which it is made. The declaration of Mr. Hayashi overcame the disclosure of WINNIK. During updating search, PG Publication was found and the rejections are restated accordingly. Applicants arguments are considered moot due to discontinuation of the rejections stated before.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Katarzyna Wyrozebski  
Primary Examiner  
Art Unit 1714

April 11, 2005